

### **REMARKS**

Claims 1, 3 to 36, 38 to 48 and 50 to 75 are pending. Claims 7 to 11, 30 to 32, 34, 39 to 41, 44, 54 to 58, 66 to 68, 70, and 73 to 75 have been withdrawn as being drawn to a non-elected species and claims 1, 3 to 6, 12 to 29, 33, 35, 36, 38, 42, 43, 45 to 48, 50 to 53, 59 to 65, 69, 71, and 72 are under examination. Claims 1, 36, 42, 43, 45, and 72 have been amended and constitutes no new matter, support for which can be found generally in the specification and drawings.

#### **Claim Rejections – 35 U.S.C. § 103**

Claims 1, 3 to 6, 12 to 29, 33, 35, 36, 38, 42, 43, 45 to 48, 50 to 53, 59 to 65, 69, 71, and 72 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,979,951 to Simpson in view of U.S. Patent No. 5,662,671 to Barbut.

Applicant respectfully traverses this rejection of the claims. Although Applicant disagrees with the Examiner, independent claims 1, 36 and 42 have been amended to recite a catheter assembly having first, second and third elongate tubular bodies. A “medical device” is “contained within the lumen of the third elongate tubular body”. The third elongate tubular body is moveable from a proximal position to a distal position and the medical device is “moveable from the lumen of the third elongate tubular body to the lumen of the second elongate tubular body when the third elongate tubular body is in the [second and/or distal] position”. Simpson in view of Barbut neither teaches nor suggests a catheter assembly that has “a medical device contained within the lumen of the third elongate tubular body” and where the medical device is “moveable from the lumen of the third elongate tubular body to the lumen of the second elongate tubular body when the third elongate tubular body is in the [second and/or distal] position”. More specifically, the Examiner has identified the cutter 106 of Simpson as being

the third elongate tubular member (body) and the distal extremity 101a of cylindrical housing 101 as being the second elongate tubular body. The device disclosed by Simpson does not have a medical device contained within the lumen of the cutter 106. Even more clearly the device disclosed by Simpson does not have a medical device contained within the lumen of the cutter 106 which is moveable from the lumen of the cutter to the lumen of the distal extremity 101a of the cylindrical housing 101 when the cutter is in a distal position. Further, Barbut contains no disclosure or teaching that would cause a person of skill in the art to modify Simpson by adding a medical device as required by these claims. Therefore, claims 1, 36 and 42 are patentable over the cited references.

Claim 43 is directed to an assembly including an embolic protection device and a catheter. The assembly has first, second and third elongate tubular bodies. The third elongate tubular body is slideable from a first position to a second position. The embolic protection device is contained within the lumen of the third elongate tubular body and is moveable from the lumen of the third elongate tubular body to the lumen of the second elongate tubular body when the third elongate tubular body is in the second position. Simpson in view of Barbut neither teaches nor suggests a catheter assembly that has these features. The discussion of Simpson above is equally relevant to this rejection. The device disclosed by Simpson does not include an embolic protection device contained within the lumen of the cutter 106. Even more clearly the device disclosed by Simpson does not have an embolic protection device contained within the lumen of the cutter 106 which is moveable from the lumen of the cutter to the lumen of the distal extremity 101a of the cylindrical housing 101 when the cutter is in a distal position. Further, Barbut contains no disclosure or teaching that would cause a person of skill in the art to modify Simpson by adding an embolic protection

device as required by these claims. Therefore, claim 43 is allowable for at least reasons similar to those set forth above with respect to claims 1, 36 and 42.

Claims 45 and 72 are method claims directed to a method for positioning a catheter assembly within a patient's blood vessel. The method includes providing a catheter having first, second and third elongate tubular bodies. The third elongate tubular body is moveable from a proximal position to a distal position. The method further includes providing a medical device that is contained within the lumen of the third elongate tubular body. The method includes the steps of "moving the third elongate tubular body from the proximal position to the distal position" and "after the third elongate tubular body is moved to the distal position moving the medical device from the lumen of the third elongate tubular body to the lumen of the second elongate tubular body." Simpson in view of Barbut neither teaches nor suggests a method having such steps as recited in claims 45 and 72. As discussed above, the device disclosed by Simpson does not have a medical device contained within the lumen of the cutter 106. Even more clearly the device disclosed by Simpson does not have a medical device contained within the lumen of the cutter 106 which is moveable from the lumen of the cutter to the lumen of the distal extremity 101a of the cylindrical housing 101 when the cutter is in a distal position. Therefore, the device disclosed by Simpson can not be used in a manner required by claims 45 and 72. Further, Barbut contains no disclosure or teaching that would cause a person of skill in the art to modify Simpson by adding a medical device as required by these claims.

Based on the foregoing Applicant respectfully submits that claims 1, 36, 42, 43, 45, and 72, the only remaining independent claims, are allowable and requests that the rejection of those claims be withdrawn. Claims 3 to 6, 12 to 29, 33, 35, 38, 46 to 48, 50 to 53, 59 to 65, 69, and 71 all depend from independent claims 1, 36, 42, 43, 45, and 72 and are allowable for at least the reasons stated above.

Therefore, Applicants request that the rejection of all pending claims be withdrawn.

Conclusion

In view of Applicants' amendments and remarks, all of the claims are believed to be in condition for allowance. Reconsideration, withdrawal of the rejections, and passage of the case to issue are respectfully requested.

If any additional fees are due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 16-2312. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our deposit account.

Respectfully submitted,

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